

*Atty Docket: HES 2000-IP-002053U1**Patent***REMARKS/ARGUMENTS*****Status of Claims***

Claims 1-5, 7-17 are pending in this patent application.

Claims 6, 18-32 have been canceled.

Claim 1 has been amended.

Applicants hereby request further examination and reconsideration of the presently claimed application.

Restriction Requirement

The election of Group I, claims 1-17 is hereby affirmed, and claims 18-32 are canceled. Applicants reserve the right to pursue claims 18-32 via a divisional application.

Claim Rejections – 35 U.S.C. § 102

Claims 1-4, 7-9 and 12-15 stand rejected under 35 USC § 102(b) as being anticipated by WO 01/02698. Applicants have amended independent claim 1 to include the limitations of dependent claim 6, which is canceled. Thus, the 35 USC § 102(b) rejection of claims 1-4, 7-9 and 12-15 over WO 01/02698 has been overcome.

Claims 1, 4, 5, 16, and 17 stand rejected under 35 USC § 102(a) as being anticipated by *Parlar* (US 6,631,764). Applicants respectfully submit that *Parlar* does not establish a *prima facie* case of anticipation as to the pending claims. According to MPEP § 2131, “[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” As noted previously, Applicants have amended claim 1 to include the limitation of claim 6, which expressly recites “wherein the additive for removing the

Atty Docket: HES 2000-IP-002053U1**Patent**

filter cake is dissolved in an oil phase of the wellbore servicing fluid.” Applicants respectfully submit that *Parlar* does not expressly teach such a limitation.

In the second to last paragraph on page 5 of the office action, the Examiner relies upon column 7, lines 35-40 as teaching an additive dissolved in an oil phase of the wellbore servicing fluid. Applicants respectfully submit that a careful examination of this portion of *Parlar* reveals that *Parlar* does not teach an additive for removing the filter cake is dissolved in an oil phase of the wellbore servicing fluid as recited in claim 1. Column 7, lines 35-40 read as follows:

Optionally, the carrier fluid (oil- or water-based carrier fluid) can further contain one or more additives such as surfactants, corrosion inhibitors, breaker aids, salts (e.g., potassium chloride), anti-foam agents, scale inhibitors, emulsifiers (at between about 0.5 and 3 wt % of the carrier fluid), organophilic clays and bactericides.

First, careful reading of this passage reveals that this passage relates to additives generally, and is not specifically addressing the recited additive for removing the filter cake. Second, careful reading of the passage further reveals that while *Parlar* discloses oil or water based carrier fluids, *Parlar* does not teach that certain additives must be present in one or the other of the phases (i.e., in the oil phase or water phase) of such carrier fluids. Such distinctions are important, as Applicants disclose the use of additives for removing the filter cake that undergo hydrolysis upon contact with water, and thus such additives are transported in the oil phase of the servicing fluid to avoid undesirable premature contact with water. Given that *Parlar* does not teach that the additive for removing the filter cake is dissolved in an oil phase of the wellbore servicing fluid as recited in claim 1, Applicants respectfully submit that claims 1, 4, 5, 16, and 17 are patentable over *Parlar*.

Atty Docket: HES 2000-IP-002053U1**Patent*****Claim Rejections – 35 U.S.C. § 103***

Claims 10 and 11 stand rejected over 35 USC § 103(a) as being unpatentable over WO 01/02698 in view of *Patel* (US 5,888,944). Assuming for sake of argument that the combination of WO 01/02698 and *Patel* is proper (and without conceding such), the Examiner has nonetheless failed to establish a *prima facie* case of obviousness as such a combination does not teach or suggest all of the claim limitations. Claims 10 and 11 each depend from and incorporate the limitations of independent claim 1 as discussed previously. As noted above, the primary reference, WO 01/02698, does not disclose each and every element of independent claim 1, and more specifically does not teach or suggest wherein the additive for removing the filter cake is dissolved in an oil phase of the wellbore servicing fluid. Furthermore, the secondary reference, *Patel*, is not cited by the Examiner for the purpose of providing such missing elements of independent claim 1. Thus, Applicants respectfully submit that claims 10 and 11 are likewise patentable over WO 01/02698 and *Patel*.

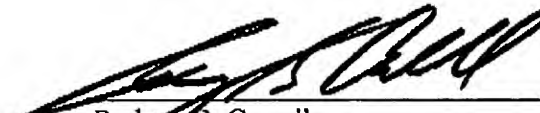
*Atty Docket: HES 2000-IP-002053U1**Patent***CONCLUSION**

Consideration of the foregoing amendments and remarks, reconsideration of the application, and withdrawal of the rejections and objections is respectfully requested by Applicants. No new matter is introduced by way of the amendment. It is believed that each ground of rejection raised in the Office Action dated October 21, 2005 has been fully addressed. If any fee is due as a result of the filing of this paper, please appropriately charge such fee to Deposit Account Number 50-1515 of Conley Rose, P.C., Texas. If a petition for extension of time is necessary in order for this paper to be deemed timely filed, please consider this a petition therefore.

If a telephone conference would facilitate the resolution of any issue or expedite the prosecution of the application, the Examiner is invited to telephone the undersigned at the telephone number given below.

Respectfully submitted,

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